

REMARKS:

Claims 1, 2, 4, and 16-22 are presented for examination, with claims 1, 2 and 4 having been amended hereby, new claims 16-22 having been added, and claims 3 and 5-15 having been cancelled, without prejudice or disclaimer.

It is noted that the Office Action Summary does not acknowledge at Paragraph 14 a claim for domestic priority under 35 U.S.C. 119(e) (to a provisional application). Applicant respectfully submits that a proper claim for domestic priority under 35 U.S.C. 119(e) (to a provisional application) was made in the present application, as filed. More particularly, it is noted that: a) the first paragraph of the present application claims the benefit under 35 U.S.C. 119(e) of U.S. Provisional Application Serial Number 60/179,537 filed February 1, 2000 and b) that the Declaration filed therewith likewise claims the benefit under 35 U.S.C. 119(e) of U.S. Provisional Application Serial Number 60/179,537 filed February 1, 2000.

Accordingly, it is respectfully requested that the claim for domestic priority under 35 U.S.C. 119(e) (to a provisional application) be acknowledged.

Reconsideration is respectfully requested of the objection to claim 1 because of the informalities noted by the Examiner in paragraph 2 of the above-identified Office Action.

In this regard, it is noted that “generation 1 data” has been amended to “first generation data” as suggested by the Examiner.

Likewise, it is noted that “generation 2 data” has been amended to “second generation data” as suggested by the Examiner.

Accordingly, it is respectfully submitted that the objection to claim 1 because of the informalities noted by the Examiner in paragraph 2 of the above-identified Office Action has been overcome.

Reconsideration is respectfully requested of the rejection of claims 1, 2 and 4 under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 6,339,767 to Rivette et al. ("Rivette et al.").

It is respectfully submitted that applicant does not necessarily concur with the Examiner in the Examiner's analysis of the claims of the present application and the Rivette et al. disclosure.

Nevertheless, in order to expedite prosecution of the application, independent claim 1 has been amended hereby to more particularly point out the feature of the invention directed to operating on the second generation data to identify or filter out at least one patent identified in the second generation data that is cited in the patent under test.

It is believed that this feature is neither shown nor suggested by Rivette et al. Thus, it is respectfully submitted that the rejection of claim 1 (as well as claims 2 and 4, which depend therefrom) have been overcome.

Moreover, it is noted that new claims 16 and 17 depend from independent claim 1. Thus, it is respectfully submitted that these claims are patentably distinct for at least the same reasons as claim 1.

Further, it is noted that new claim 18 substantially tracks claim 1, with the exception that the second generation data of claim 18 relates to at least one patent in the database which cites (as opposed to being cited in) at least one patent identified by the first generation data. In this regard, it is noted that new claim 18, like claim 1, recites the feature of the invention directed to operating on the second generation data to identify or filter out at least one patent identified in the second generation data that is cited in the patent under test. Thus, it is respectfully submitted that new claim 18 is patentably distinct for at least the same reasons as claim 1.

Further still, it is noted that new claims 19-22 depend from independent claim 18. Thus, it is respectfully submitted that these claims are patentably distinct for at least the same reasons as claim 18.

Finally, applicant respectfully notes that this Amendment is fully supported by the originally filed application and thus, no new matter has been added. For this reason, the Amendment should be entered.

More particularly, support for amendment to claim 1 is found in claims 1 and 5, as filed; page 17, line 30 to page 21, line 23; page 22, line 23 to page 24, line 4; page 24, line 13 to page 25, line 5; page 26, lines 11 to 27; page 43, line 22 to page 44, line 8; and throughout the specification. Further, support for amendment to claim 2 is found in claims 1 and 2, as filed; page 17, line 30 to page 21, line 23; and throughout the specification. Further still, support for amendment to claim 4 is found in claims 1 and 4, as filed; page 17, line 30 to page 21, line 23; page 25, lines 7 to 25; and throughout the specification. Further still, support for new claim 16 is found in claims 1 and 4, as filed; page 17, line 30 to page 21, line 23; page 25, lines 7 to 25; and throughout the specification. Further still, support for new claim 17 is found in claims 1 and 5, as filed; page 17, line 30 to page 21, line 23; page 22, line 23 to page 24, line 4; page 24, line 13 to page 25, line 5; page 26, lines 11 to 27; page 43, line 22 to page 44, line 8; and throughout the specification. Further still, support for new claim 18 is found in claims 1 and 5, as filed; page 17, line 30 to page 21, line 23; page 22, line 23 to page 24, line 4; page 24, line 13 to page 25, line 5; page 26, lines 11 to 27; page 43, line 22 to page 44, line 8; and throughout the specification. Further still, support for new claim 19 is found in claims 1 and 2, as filed; page 17, line 30 to page 21, line 23; and throughout the specification. Further still, support for new claim 20 is found in claims 1 and 4, as filed; page 17, line 30 to page 21, line 23; page 25, lines 7 to 25; and throughout the specification. Further still, support for new claim 21 is found in claims 1 and 4, as filed; page 17, line 30 to page 21, line 23; page 25, lines 7 to 25; and throughout the specification. Further still, support for new claim 22 is found in claims 1 and 5, as filed; page 17, line 30 to page 21, line 23; page 22, line 23 to page 24, line 4; page 24, line 13 to page 25, line 5; page 43, line 22 to page 44, line 8; and throughout the specification.

In conclusion, it is respectfully submitted that each objection and rejection made by the Examiner in the January 29, 2003 Office Action has been overcome and that all of the pending claims are now in condition for allowance.

Favorable reconsideration is earnestly solicited.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

 6/26/03
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Date